REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1 and 24 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, Claims 1-69 are now pending in this application.

In section 2 of the Office Action, the Examiner rejected Claims 47-49, 52, 54-55, 61, 64 and 66-67 under 35 U.S.C. § 103(a) as being unpatentable over Ito et al. (U.S. published application no. 2001/0042149) in view of "Socket to Support World's Smallest Plug-in Card for Mobile Connectivity" (SD Card Association – Press Room, June 26, 2000) (hereinafter SDA).

In reference to independent Claim 47, Applicants respectfully submit that <u>Ito et al.</u> does not disclose, teach, or suggest that the accessory device interface, which Applicants claim as an SDIO interface and the expansion slot, which Applicants disclose as an SD expansion slot, use the same interface and therefore, the accessory device interface and the expansion slot are the same type of card and interface. <u>Ito et al.</u> teaches that the accessory device is a PCMCIA interface and has an SD card slot. <u>Ito et al.</u> discloses that the peripheral device 1, which is the PCMCIA device, has a function as a converting adapter for another card-type information device or storage medium, such as an SD card. See <u>Ito et al.</u>, par. [0032]. Accordingly, the teachings of <u>Ito et al.</u> are contrary to the invention of Applicants' Claim 47 which includes an SDIO interface for the accessory device with an SD slot for an expansion card. Thus, the type of card which is to be inserted into the expansion slot is the same as the type of interface which is used in the portable electronic device. Because of the teachings in Ito et al., there is no logical reason why

the teachings of <u>SDA</u> would be combined with the teachings of <u>Ito et al.</u> to arrive at the invention recited in independent Claim 47. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Because <u>Ito et al.</u> teaches that the peripheral device 1 is a converting adapter for another card type, there is no desirability to combine the teachings of <u>Ito et al.</u> with the teachings of <u>SDA</u> to arrive at Applicants' invention. Therefore, Applicants respectfully submit that independent Claim 47 and its dependent claims are therefore allowable.

In section 11 of the Office Action, the Examiner rejected Claims 1-3, 14, 18-21, 23-26, 37, 41-44 and 46 under 35 U.S.C. § 103(a) as being unpatentable over (Harari, U.S. Patent No. 6,266,724) in view of SDA, and further in view of Jones et al. (U.S. Patent No. 6,438,638). Applicants respectfully submit that independent Claim 1 has been amended to recite "a secure digital input-output (SDIO) card including an interface configured to be coupled to the handheld computer in a slot in a housing of the handheld computer" and "an expansion slot coupled to the SDIO card, the expansion slot configured to selectively coupled to one of a secured digital (SD) card and a multimedia card (MMC), the slot configured to be located overlying a back side of the handheld computer." Similarly, independent Claim 24 has been amended to recite "an expansion slot coupled to the SDIO card, the slot located overlying a back side of the housing, the expansion slot configured to selectively coupled to one of a secured digital (SD) card and a multimedia card (MMC)." Applicants respectfully submit that nowhere in any of Harari et al, SDA, or Jones et al. is there disclosed a secure digital input-output card that has an accessory device with an expansion slot and the expansion slot of the SDIO card being located overlying a back side of the housing of the handheld computer. Applicants respectfully submit that the advantage of doing so is that the SD-MMC slot is out of the way of use of the portable electronic device or the handheld computer, because it is in back of the device. See, e.g., specification, FIG. 5. Accordingly, Applicants respectfully submit that independent Claims 1 and 24, as amended are allowable. Further, Applicants respectfully submit that claims depending from independent Claims 1 and 24 are also allowable.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date August 02, 2004

FOLEY & LARDNER LLP

777 East Wisconsin Avenue

Milwaukee, Wisconsin 53202-5306

Telephone:

(414) 297-5730

Facsimile:

(414) 297-4900

Alistair K. Chan

Attorney for Applicants Registration No. 44,603